

REMARKS

Claims 54 to 76 are pending in this application, and have been rejected by the Examiner.

35 U.S.C. § 103

The Examiner rejected claims 54-76 "under 35 U.S.C. § 103(a) as being unpatentable over Gordon et al. (U.S. Patent No. 5,932,612)." Applicant traverses this rejection for at least the following reasons.

Under 35 U.S.C. § 103, all of the elements of the Applicant's claims must be set forth in the references and there must be at least a suggestion to modify the references in the manner needed to teach all of the claimed elements. The Examiner states that Gordon is silent on the "teaching of the composition having a specific pH of about 5.5 to about 8.0, the pH is an inherent characteristic and is encompassed therein." Gordon does not teach the specified pH ranges set forth in Applicant's claims. While Applicant agrees that pH is an inherent characteristic, which only means that the composition must have a pH. Nothing teaches or suggests the modification of Gordon to Applicant's claimed pH range.

Additionally, as Applicant stated in paragraph 8 of the specification, the specified pH is surprising, and causes an unexpected result, because compositions with these components are not known to be stable in the claimed pH range. Nothing in Gordon teaches that Gordon's composition would inherently have the claimed pH. Therefore, Gordon cannot be said to teach the claimed pH, which as is noted in Applicant's specification in paragraph 8, is a surprising characteristic of a composition containing hydroquinone and cationic salts of acidic ascorbyl esters. Hydroquinone in the prior art discolors at the pH range of 7.0 to 8.5, and the recommended pH in the prior art for cationic of acidic ascorbyl esters is about 7.0 to 8.5. Therefore, it is an unexpected benefit of the Applicant's invention to have a hydroquinone composition at around neutral pH. Gordon would not inherently have neutral compositions (in

Applicant's claimed range of about 5.5 to about 8.0), since one of ordinary skill in the art would expect Gordon's composition at Applicant's pH to discolor.

Therefore, since Gordon does not teach all of the claimed elements and does not suggest a modification of the invention to include all of the claimed elements, Applicant respectfully requests removal of this rejection.

Provisional Double Patenting Rejection

According to the Examiner, "Claims 54-76 of this application conflict with claims 77-106 of Application No. 10/616,813. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application." The Examiner provisionally rejected the pending claims under the doctrine of obviousness-type double patenting.

Applicant traverses this provisional rejection for at least the following reasons.

On October 2, 2002, the PTO Examiner in Application No. 09/864,083 issued a restriction requirement, and the currently pending application at issue (No. 10/616,778) is a divisional application required by the PTO. Under MPEP 804.01 "Prohibition of Double Patenting Rejections" and 35 U.S.C. § 121, the use of a patent issuing from an application which was filed as the result of a restriction requirement cannot be used against a divisional application. Therefore, there is a prohibition against this provisional double patenting rejection because both the Application at issue and Application No. 10/616,813 are divisional applications filed as a result of the same restriction requirement in their parent Application No. 09/864,083. Applicant respectfully requests that this rejection be withdrawn.

CONCLUSION

Applicant respectfully submits that the application is in condition for allowance.

Applicant does not believe any additional fee is required for this Response and Request for Reconsideration, however, in the event any additional fee is required or any overpayment credit is due, the Commissioner is hereby authorized to charge Deposit Account No. 18-0586.

I hereby certify that this paper and the papers referred to herein as being transmitted, submitted, or enclosed herewith in connection with U.S. Serial No. 10/616,778 are being facsimile transmitted to the United States Patent and Trademark Office fax number 703-872-9306 on the date shown below.

Maryellen Feehery
Maryellen Feehery

October 19, 2004

Date of Facsimile Transmission

Respectfully submitted,

REED SMITH LLP

Maryellen Feehery
Maryellen Feehery
Registration No. 44,677
William J. McNichol, Jr.
Registration No. 31,179
2500 One Liberty Place
1650 Market Street
Philadelphia, PA 19103-7301
(215) 241-7988
Attorneys for Applicant